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12-08-03

2121



Practitioner's Docket No. 1250.04

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: William A. Dodd)

Serial No.: 10/065,467)

Filed: 07/26/2002)

For: Fleet Maintenance Method)

Art Unit: 2121
Examiner: Bot, LeDinh

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Technology Center 2100

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF RENEWED PETITION TO MAKE SPECIAL

1. Transmitted herewith is a Request for Reconsideration. Applicant requests reconsideration of the decision.

Signature of Practitioner
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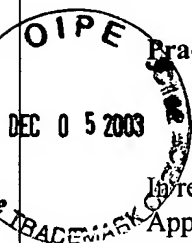
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CERTIFICATE OF MAILING
(37 C.F.R. § 1.10)

I HEREBY CERTIFY that this correspondence is being deposited with the United States Postal Service as Express Mail Service Label No. **EL992693027US** in an envelope addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 5, 2003.

Date: December 5, 2003

Shelley Butz



Practitioner's Docket No. 1250.04

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In re application of: William A. Dodd, Jr.
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REQUEST FOR RECONSIDERATION
37 CFR 1.111

Dear Sir,

In response to the Decision on Renewed Petition for Accelerated Examination under M.P.E.P. §708.02(VIII) mailed November 19, 2003, applicant offers this Motion for Reconsideration to the Decision on Renewed Petition to Make Special. The initial petition was dismissed as being deficient under M.P.E.P. §708.02(d) & (e). Specifically, the original decision stated;

"Petitioner does not submit a detailed discussion of the references **deemed most closely related to the subject matter encompassed by the claims**. Petitioner briefly discusses the references. Petitioner even states that 'a brief discussion of each reference is provided to illustrate the field of search.' Thus, Petitioner does not comply with both items (d) & (e) [above]." (Emphasis in original).

Although the Office is correct in the recitation regarding the brief discussion of certain references, it is important to note that the brief discussions pertained only to those references deemed to be immaterial to patentability. The inclusion of such information was only included to indicate the extensive field of search. Read together, 37 C.F.R. §1.102(d) and (e) require only a **detailed** discussion of the references **deemed most closely related to the subject matter encompassed by the claims**. Thus the inclusion of a brief discussion of immaterial references in no way creates a deficiency under the Patent Rules.

The Office asserts as a second basis for the dismissal that Petitioner failed to point out how the claimed subject matter is patentable over the references with the requisite particularity set forth in 37 C.F.R. §1.111(b) & (c). Furthermore, the Office states that Petitioner "does not compare the references with subject matter claimed in the independent claim 1, limitation by limitation." Also "Petitioner compares the references with subject matter which is not claimed." However, there is no requirement in 37 C.F.R. §1.111,

Renewed Petition to Make Special
In re William A. Dodd, Jr.

Ser. No. 10/065, 467
Filing Date: 07/26/2002

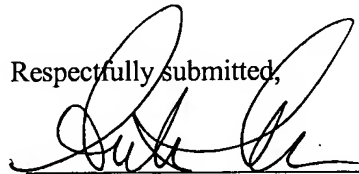
Examiner: Patel, Ramesh
Art Unit: 2121

or any other patent rule, that a petitioner compare each reference claim by claim. MPEP §708.02 sec. VIII(E) requires on that the detailed discussion point out how the claimed subject matter is patentable over the references, with the particularity required by 37 C.F.R. §1.111(b) & (c). In turn 37 C.F.R. §1.111(c) is inapplicable as it pertains only to "amending in reply to a rejection of claims in an application or patent under reexamination." 37 C.F.R. §1.111(b) only requires the reply to present arguments pointing out the specific distinctions believed to render the claims patentable over any applied references. There is no requirement for a limitation by limitation distinction.

In support the Office refers to Petitioner's discussion of the "'729 patent," in which Petitioner distinguishes the '729 patent from the current application in that the '729 patent does not describe a method for comparing sales and usage data claimed by the present application. The Office deems this discussion deficient in that "[T]his method for comparing sales and usage data is not claimed, at least not in the independent claim 1." Petitioner can find no support for the contention that the discussion of patentability be restricted to the independent claims. The method in question is clearly claimed in dependant claim 2.

Petitioner has met the requirements set forth in the patent rules regarding such a petition. If the Office deems the claims themselves are not patentable at this time the proper mechanism for such objection is in the examination process, not the petition stage. Therefore Petitioner requests reconsideration and offers this Petition for Reconsideration of Examiners Dismissal of Renewed Petition to Make Special. The petition is resubmitted and deemed to be in compliance with M.P.E.P. §708.02.

Respectfully submitted,



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